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OIPE IAP30 JAN 10 2006 PATENT & TRADEMARK OFFICE

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
EMT-001

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 1/5/06

Signature Alyson J. Lucas

Typed or printed name Alyson J. Lucas

Application Number	Filed
09/664,226	September 18, 2000

First Named Inventor: Li

Art Unit	Examiner
3624	Colbert, Ella

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. Registration number 50,389

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Robert S. Blasi, Esq.
Typed or printed name

617-570-1408
Telephone number

January 5th 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S):	Li et al.		
APPLICATION NO.:	09/664,226	ART UNIT:	3624
FILING DATE:	September 18, 2000	EXAMINER:	Colbert, Ella
TITLE:	Auction Management		

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COMMENTS ACCOMPANYING REQUEST
FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Office Action mailed on September 12, 2005, we respectfully submit these Comments:

Remarks begin on page 2 of this paper; and

Conclusion begins on page 5 of this paper.

In accord with the Official Gazette Notice of July 12, 2005, this paper accompanies a Pre-Appeal Brief Request for Review, a Notice of Appeal, and the fee for the filing of the Notice of Appeal.

Through the enclosed petition and accompanying check for the required fee, we hereby request a one-month extension of the date for reply to January 12, 2005.

The Applicants believe that no additional fees are due with this Response, but the Commissioner is hereby authorized to charge any required fees to Deposit Account No. 07-1700.

REMARKS

The Claims Satisfy 35 U.S.C. § 112

Claims 1 and 27 were said to lack antecedent basis for the elements "subset of suppliers," "selected suppliers," and "selected subset of suppliers." Claims 1 and 27 both recite a "set of suppliers," from which a "subset of suppliers" is subsequently selected. Any "set" will inherently include a number of "subsets," and accordingly this rejection is clear error.

The claims were also said to lack agreement for use of both "selected suppliers" and "selected supplier." A selected "subset of suppliers," like any set, may include any number of suppliers. When one supplier is claimed, the claims use the singular form; when more than one supplier is claimed, the claims use the plural form. This rejection is also clear error.

The Drawings Satisfy 37 C.F.R. § 1.121(d)

Corrected drawings were requested because "in fig.'s 6, 8-14, 15A, 15B, 16A, 16B, 17, 19, 20A, 20B, and 21-28 the shaded portion of the drawing figure's are not legible. The shading needs to be removed in order to read the text in the drawing figures." Office Action at 3.

A copy of Figures 6, 8–14, 15A, 15B, 16A, 16B, 17, 19, 20A, 20B, and 21–28 were obtained using the Office's PAIR system from the formal drawings filed on August 26, 2002, and are attached to these Comments as Exhibit A. Each of these figures bears the stamp of the Office of Initial Patent Examination, and none of these figures includes either shading or unreadable text. Accordingly, this rejection is clear error.

The Rejection Over *Shkedy* Fails to Consider Two Essential Elements of the Pending Claims

The Examiner has failed to consider two essential elements of independent claims 1 and 27 in rejecting those claims over United States Patent No. 6,260,024 to *Shkedy*. Accordingly, we respectfully submit that this rejection is improper and that claims 1 and 27, and the claims that depend therefrom, are allowable over *Shkedy*.

Independent claims 1 and 27 both recite, in part: (1) "utilizing, by a programmed computer, the objective function to select a subset of suppliers and determine an optimal award schedule for at least partial satisfaction of said requisition utilizing the selected suppliers," and (2) where the "objective function" includes "non-price criteria." (emphasis added) We

respectfully submit that *Shkedy* neither teaches nor suggests the use of non-price criteria in an objective function or the determination of an optimal award schedule.

In overview, the present invention relates to "a computer-implemented method for determining an optimal award schedule for at least partial satisfaction of [a] requisition." Application at ¶ 0011. A prospective buyer specifies constraints that prospective suppliers are invited to satisfy. Id. at ¶ 0012. The buyer's constraints may include traditional price terms, such as a maximum price per item, but they may also include non-price terms such as time to satisfaction, quality, and quantity. Id. at ¶ 0013.

Prospective suppliers submit bids responsive to the buyer's constraints and the system determines an optimal award schedule from those bids. Id. That is, in a typical auction in accord with the present invention, numerous suppliers will propose bids that more or less satisfy the buyer's requirements. The inventive system will then determine which subset of those bidding suppliers will optimally satisfy the bid, evaluating each bid against the price and non-price terms specified by the buyer. "The optimal combination of suppliers, together with the list of items to be ordered from each supplier, is referred to as an optimal award schedule." Id. at ¶ 0006 (emphasis added). The "objective function" is the formulation of the buyer's price and non-price constraints and the seller's constraints in its bid that is used by an optimization engine to determine the optimal award schedule. Id. at ¶ 0143.

In contrast, *Shkedy* describes a system for aggregating individual buyers' purchase requirements into a single collective purchase requirement, and providing that collective purchase requirement to sellers willing to bid on the collective purchase requirement. *Shkedy* at Abstract. *Shkedy* teaches a simple "winner-take-all" system, where one seller providing the best bid wins all of the business. Id. at col. 3, ln. 55-57; col. 3, ln. 9-11; col. 6, ln. 29-30. In contrast, the applicants' invention creates an "optimal award schedule" that allows multiple sellers to satisfy a buyer's requisition in an optimal fashion, Application at ¶ 0006, and is recited in the claims as "utilizing, by a programmed computer, the objective function to select a subset of suppliers and determine an optimal award schedule for at least partial satisfaction of said requisition utilizing the selected suppliers" (emphasis added).

Moreover, while *Shkedy* allows prospective buyers to specify non-price criteria, such as a quantity, a pool date, and an outside delivery date, *Shkedy* at col. 5, ln. 13-16, *Shkedy* does not

appear to teach that a prospective seller may provide bids that do not conform to these non-price criteria, or how to weigh a prospective seller's non-conforming non-price criteria against a bidded price. In contrast, as recited in the claims, the applicant's invention allows a prospective buyer to specify an "objective function" including "non-price criteria" that adjusts a supplier's bidded price by a "penalty term that depends on non-price factors associated with that supplier, such as the supplier's performance attributes, and a measure of how important the buyer considers those performance attributes." Application at ¶ 154. The use of the objective function including non-price criteria allows for the creation of an award schedule that is optimal with respect to both price and non-price criteria. Again, *Shkedy* appears to simply teach a winner-based all system that lets one seller providing a bid with the best price win all of a collectively-aggregated sale that includes non-price requirements.

The rejection of independent claims 1 and 27 is solely based on *Shkedy*, and the preceding discussion demonstrates how *Shkedy* fails to satisfy two essential elements of these claims. For these reasons, we respectfully submit that the rejection of independent claims 1 and 27 over *Shkedy* is clear error and we request the withdrawal of these rejections. The remaining claims, which depend therefrom, are therefore allowable.

CONCLUSION

In light of the foregoing, we respectfully submit that there are clear errors in the Examiner's rejections and that the Examiner has failed to consider essential elements of the independent claims in the present rejection.

Respectfully submitted,

Date: January 5, 2006

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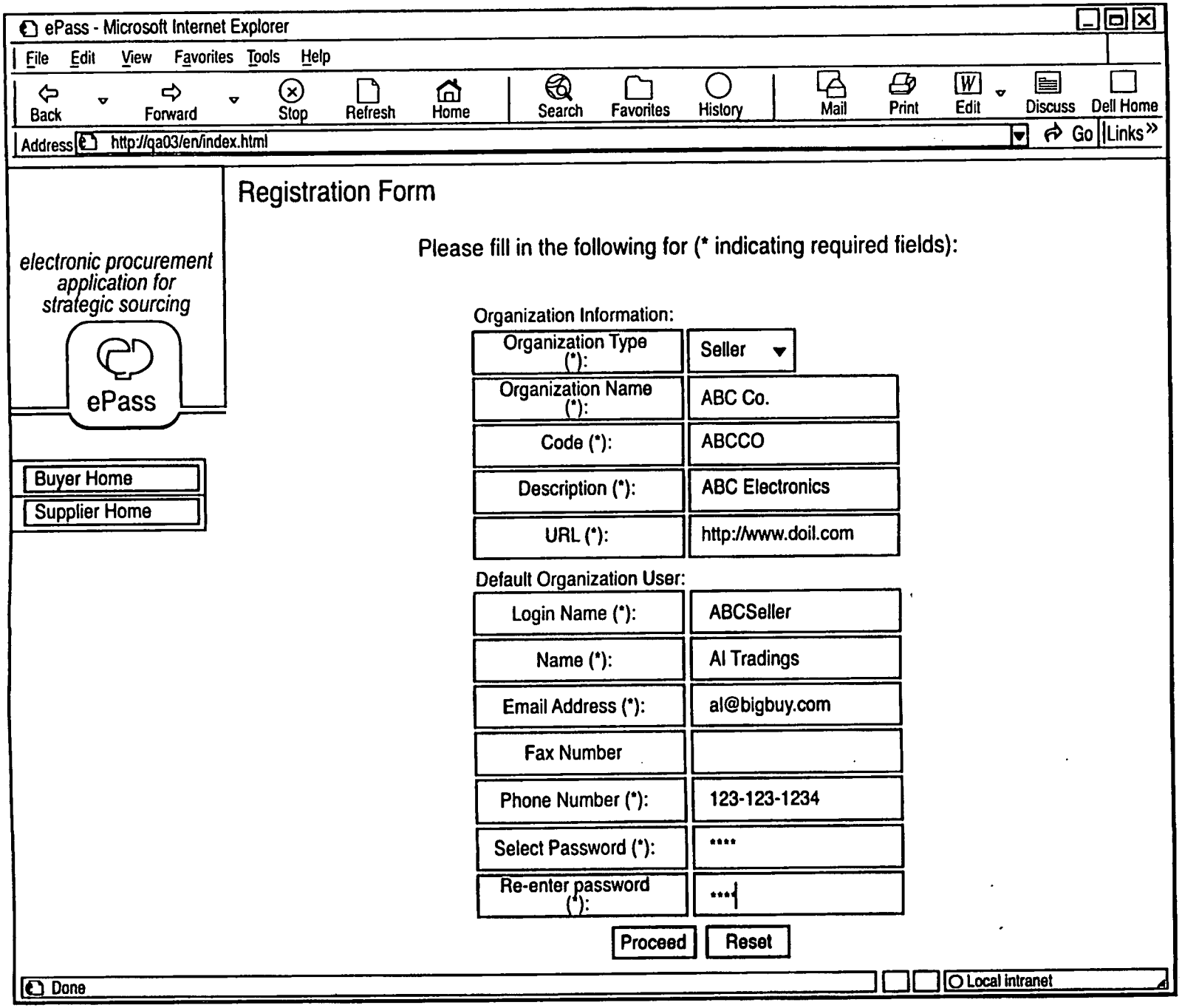

FIG. 6

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OIPE JAN 1 0 2006 PATENT & TRADEMARK OFFICE
Appln No.: 09/664,226
Applicant(s): Ge Li et al.
AUCTION MANAGEMENT
Page 6 of 40
Exhibit A

SEP 0 3 2002
PATENT & TRADEMARK OFFICE

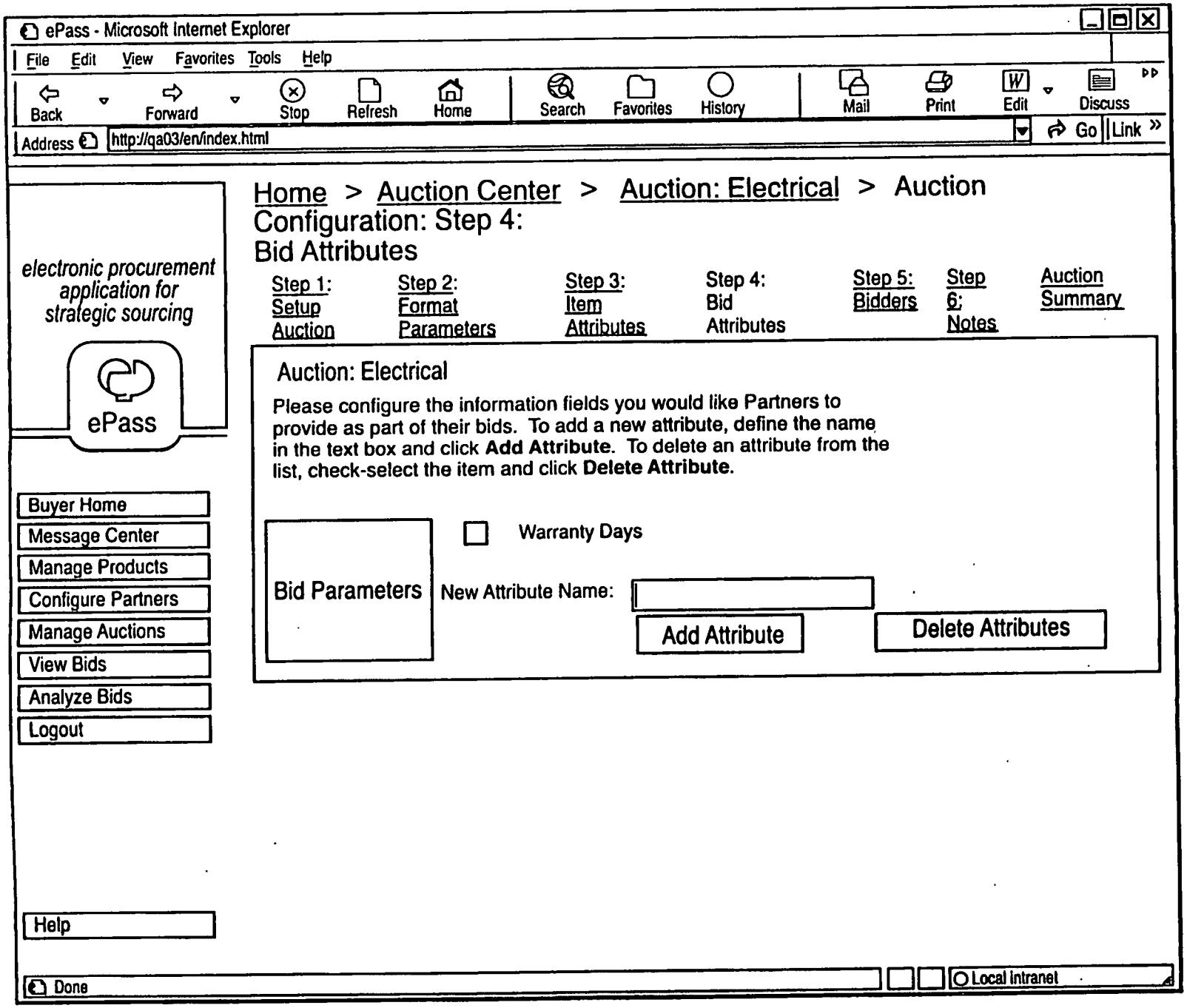

FIG. 8

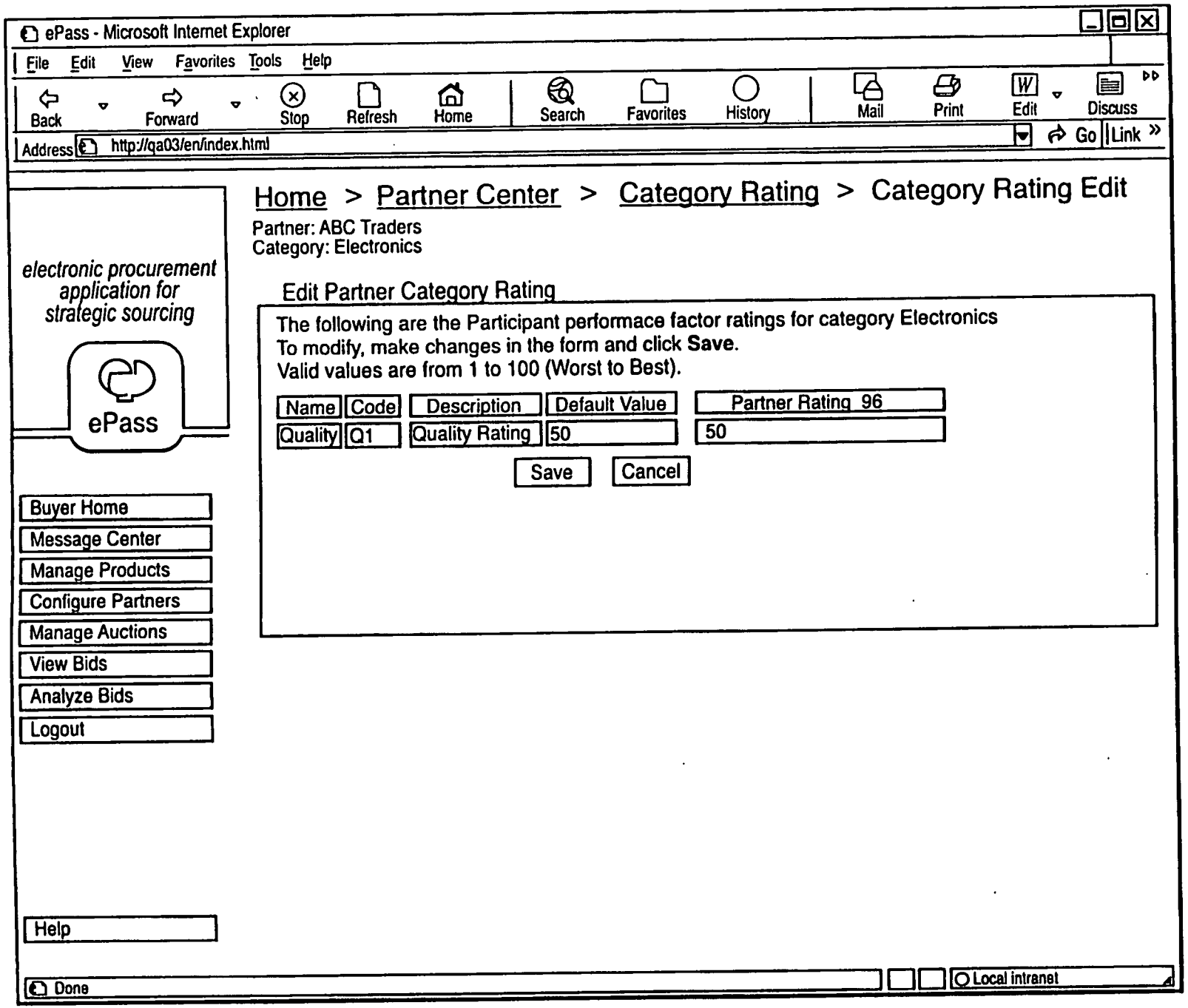

FIG. 9

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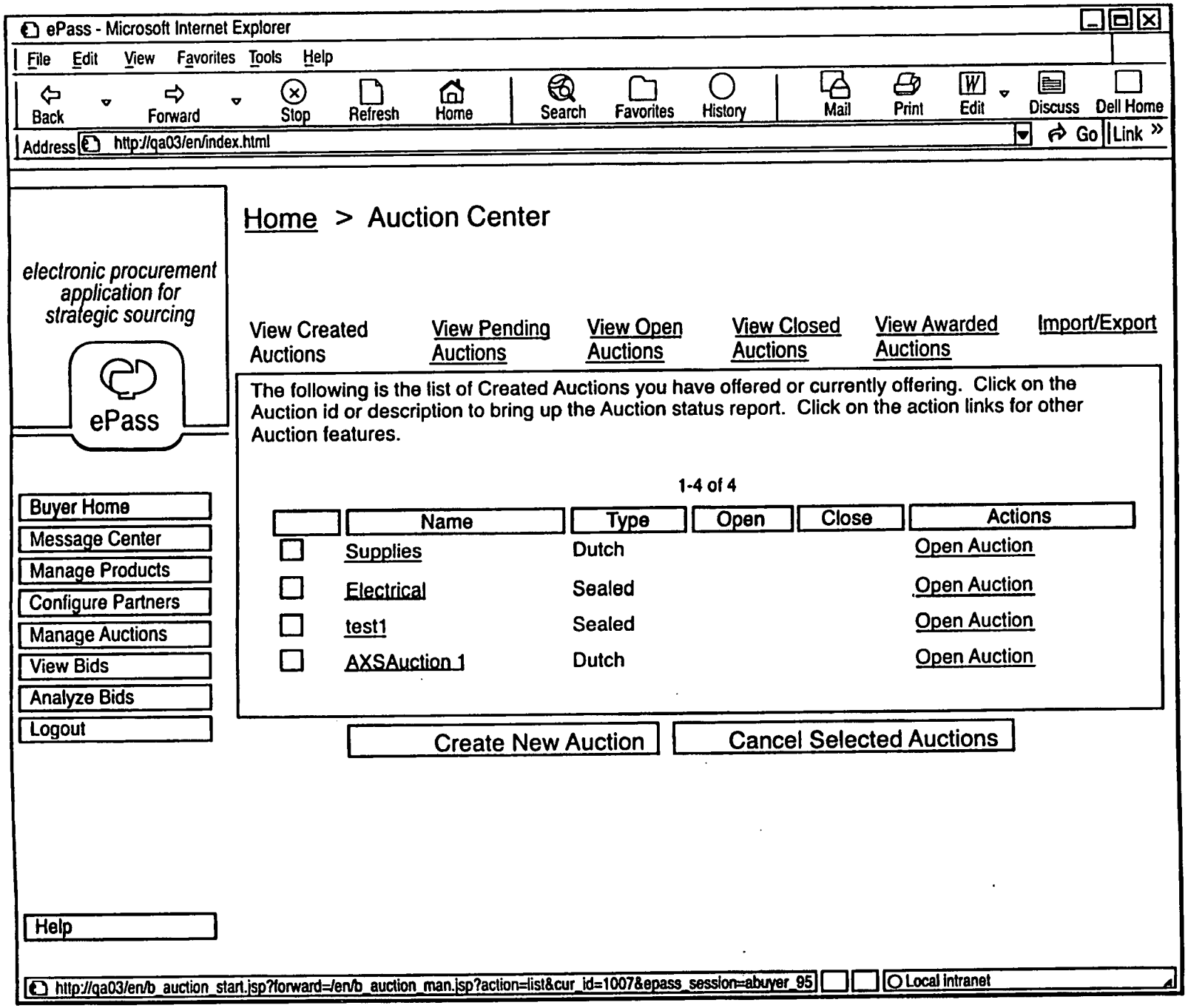

FIG. 10

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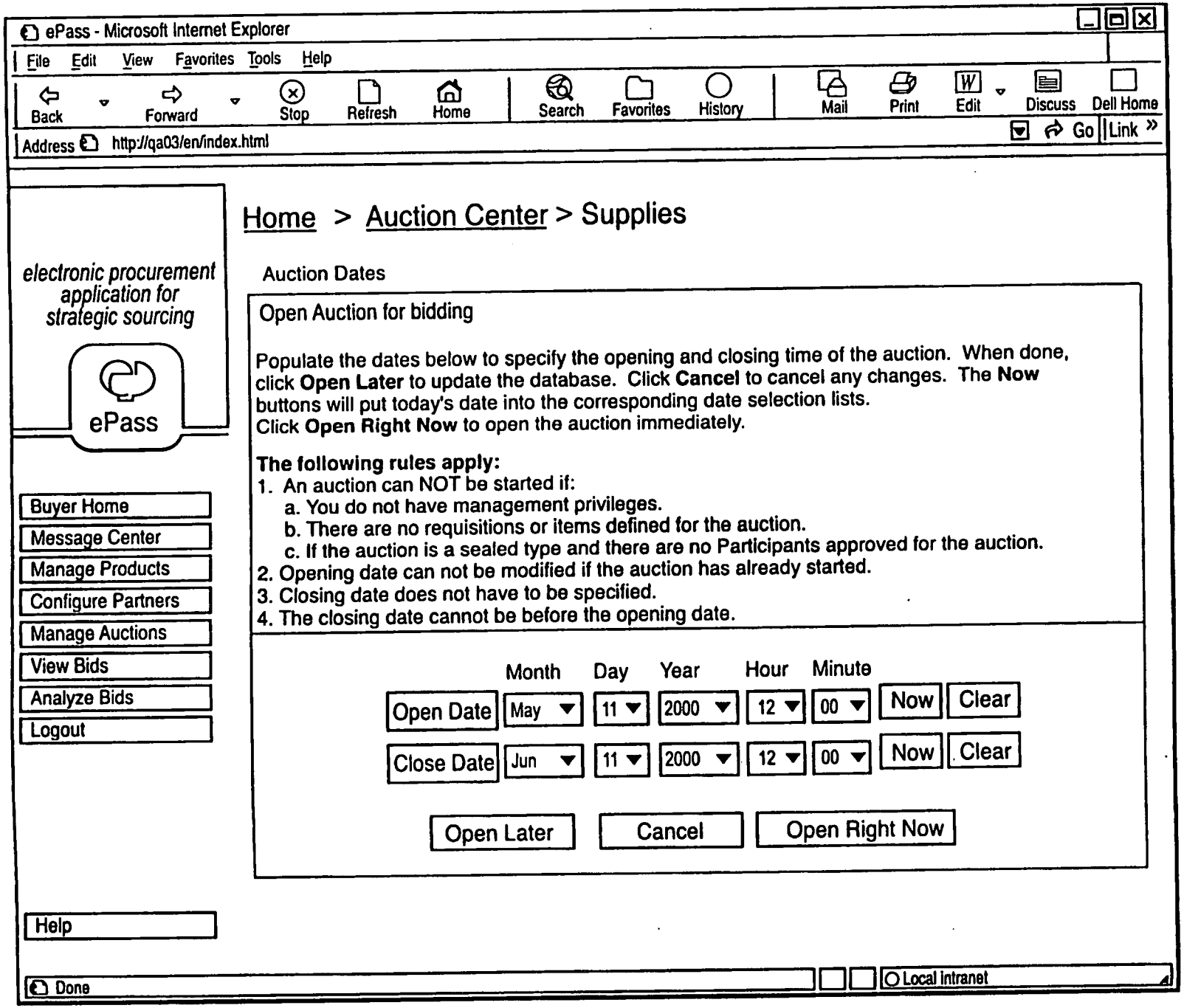

FIG. 11

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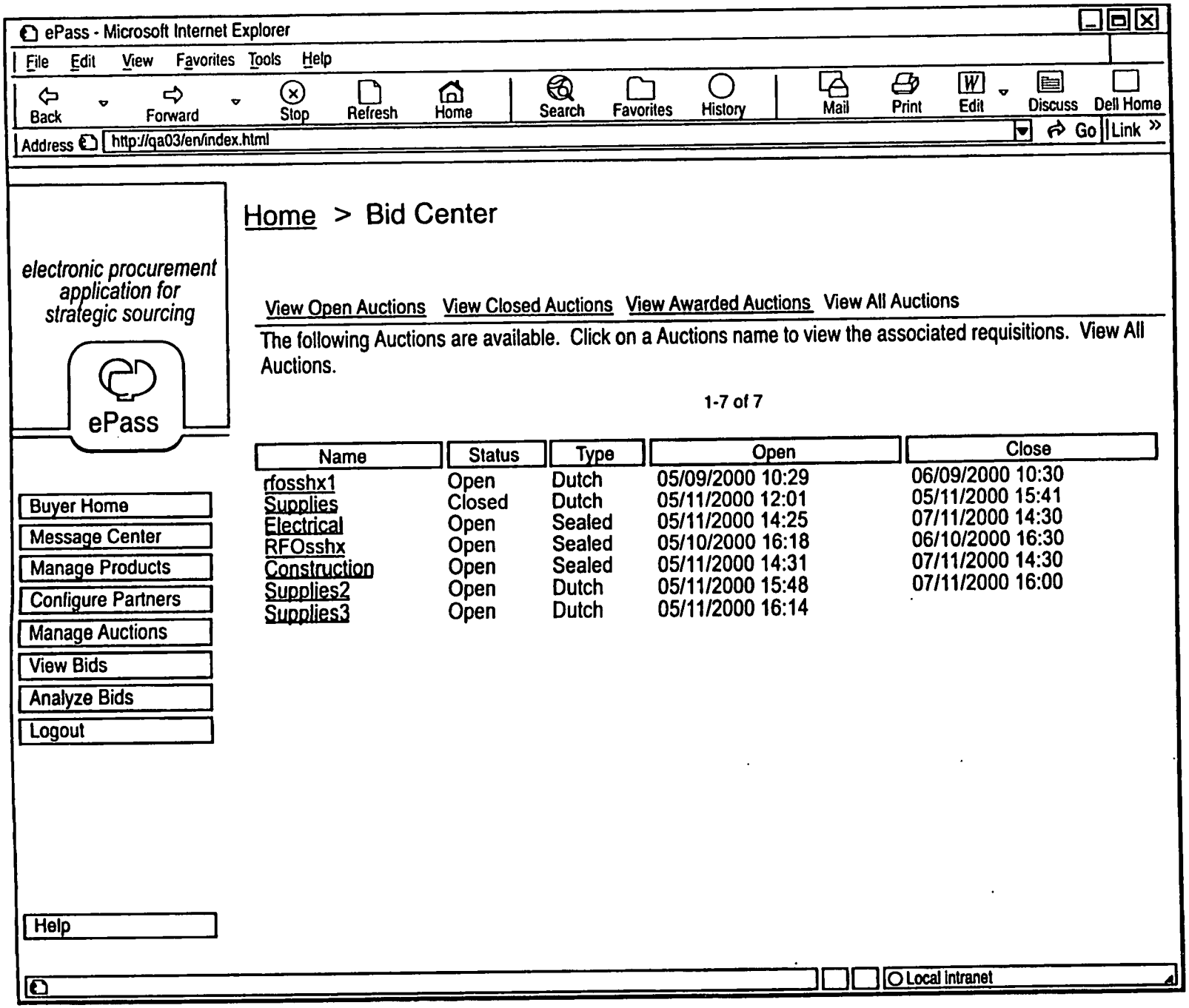

FIG. 12

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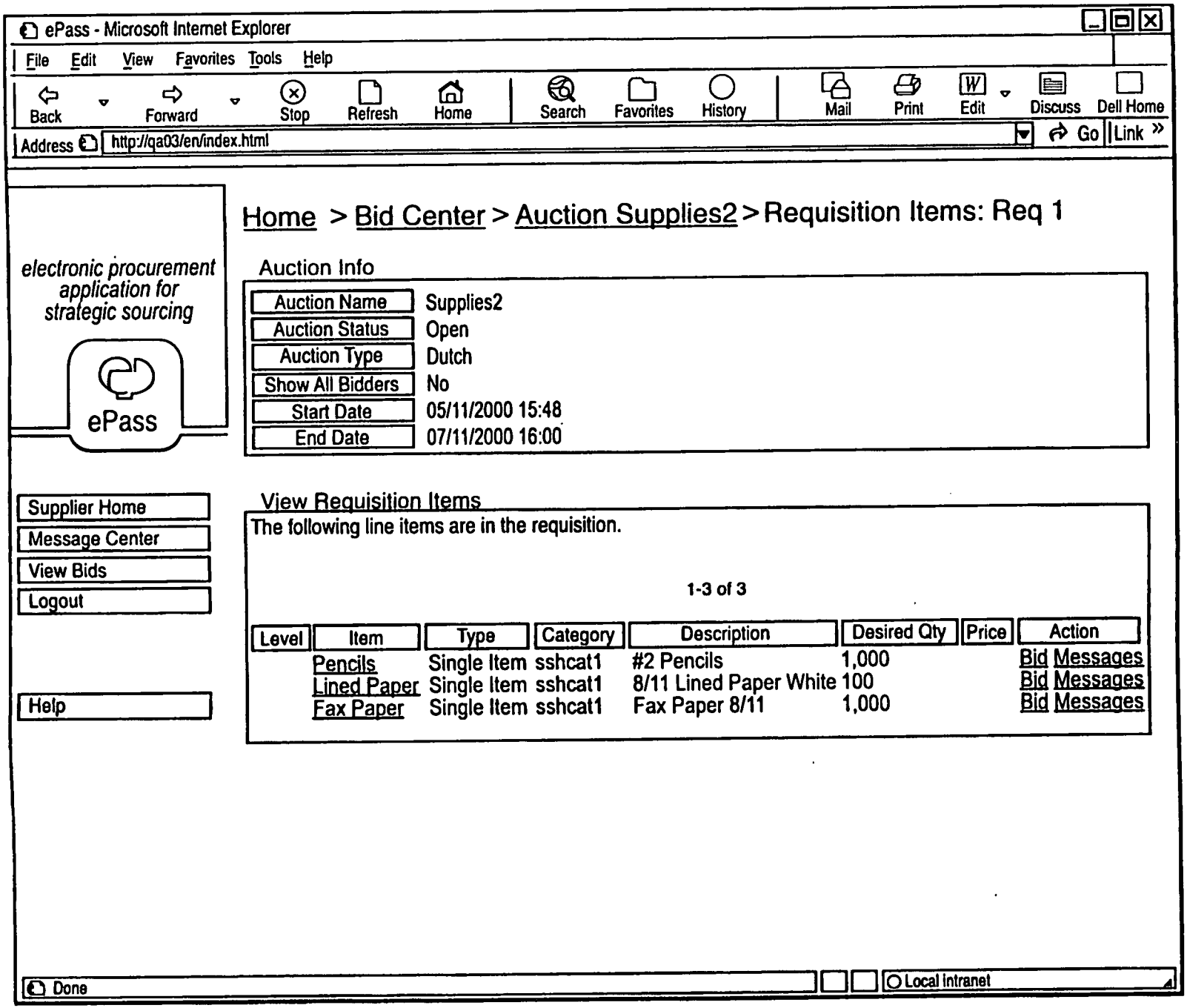

FIG. 13

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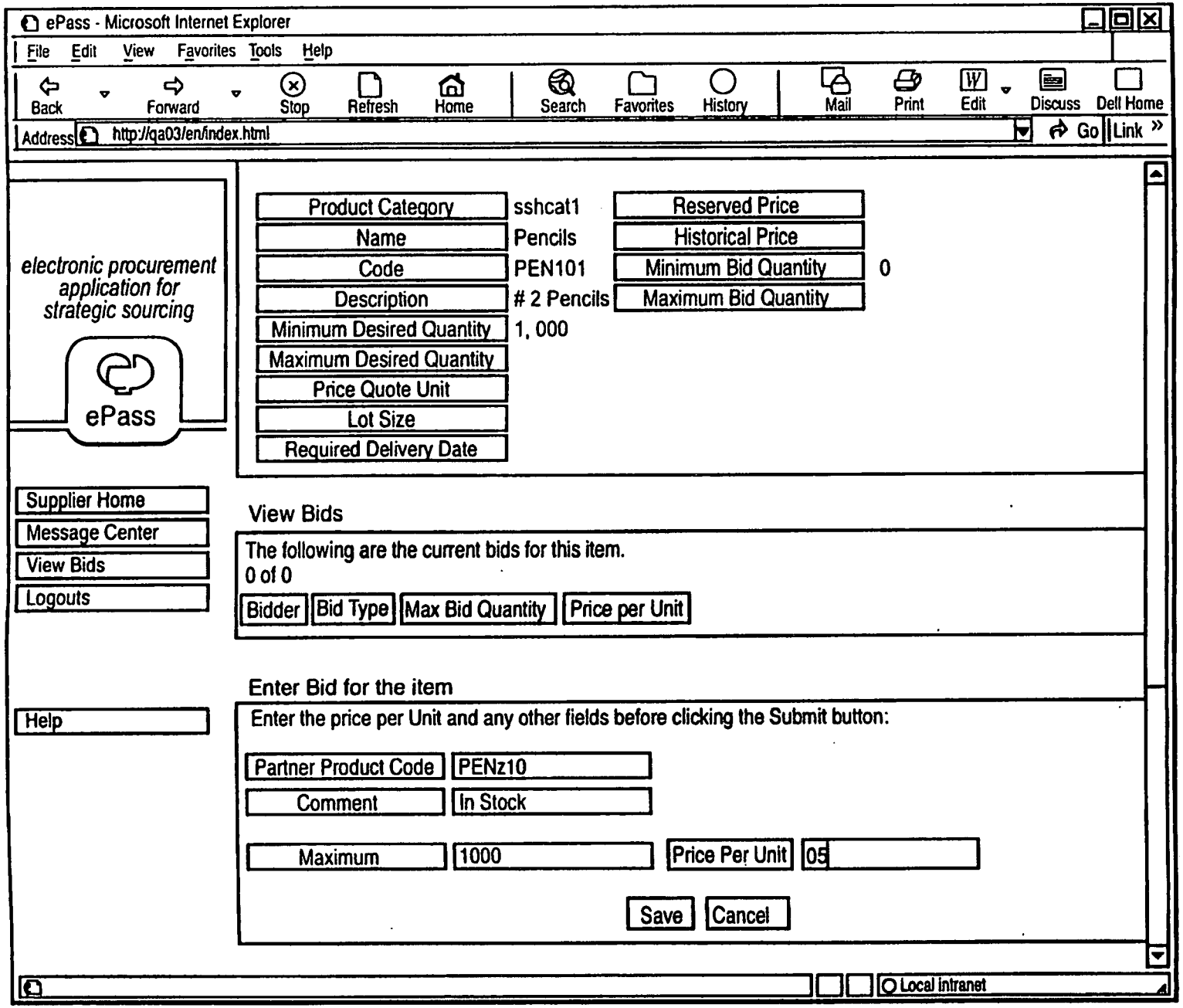

FIG. 14

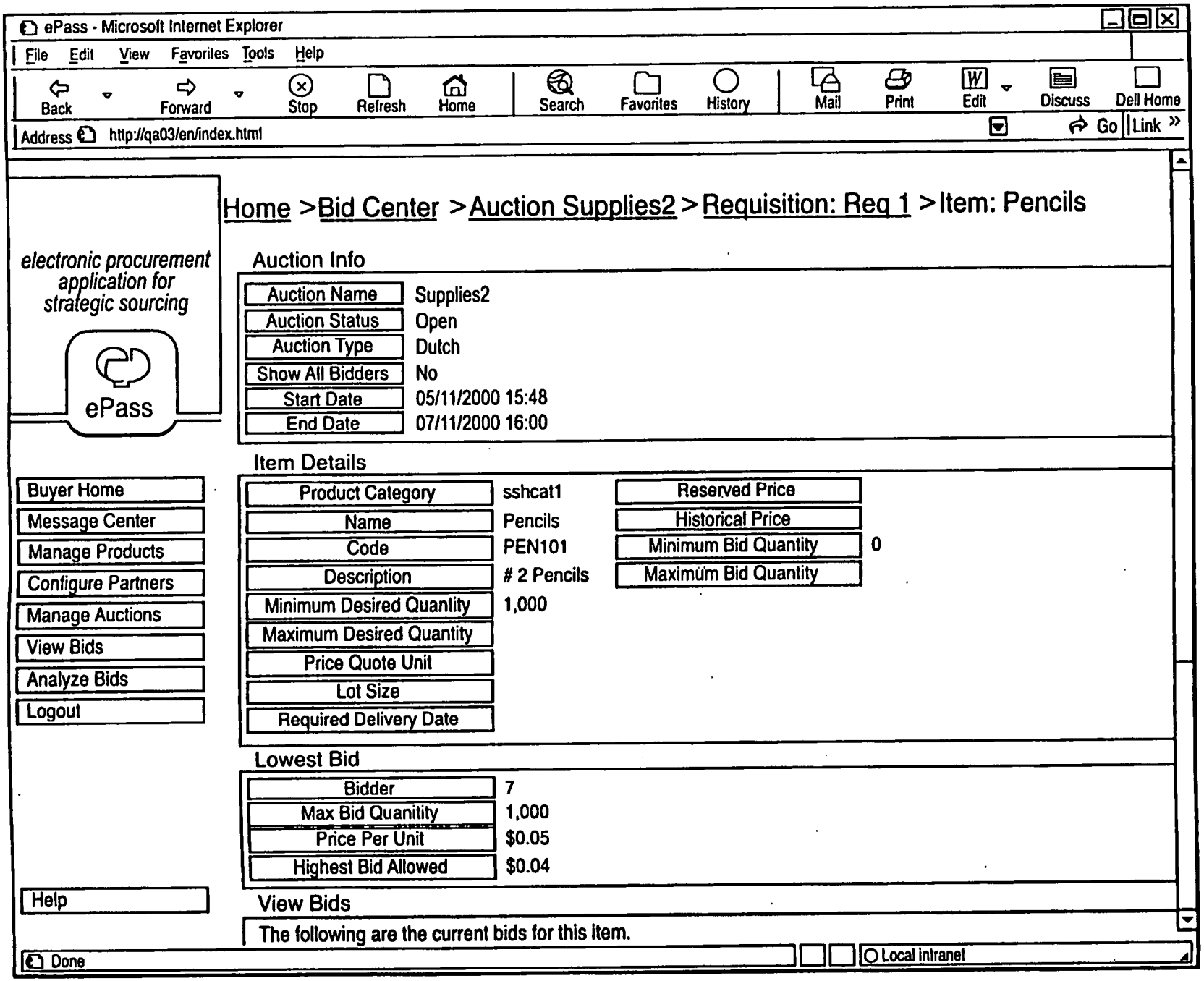

FIG. 15A

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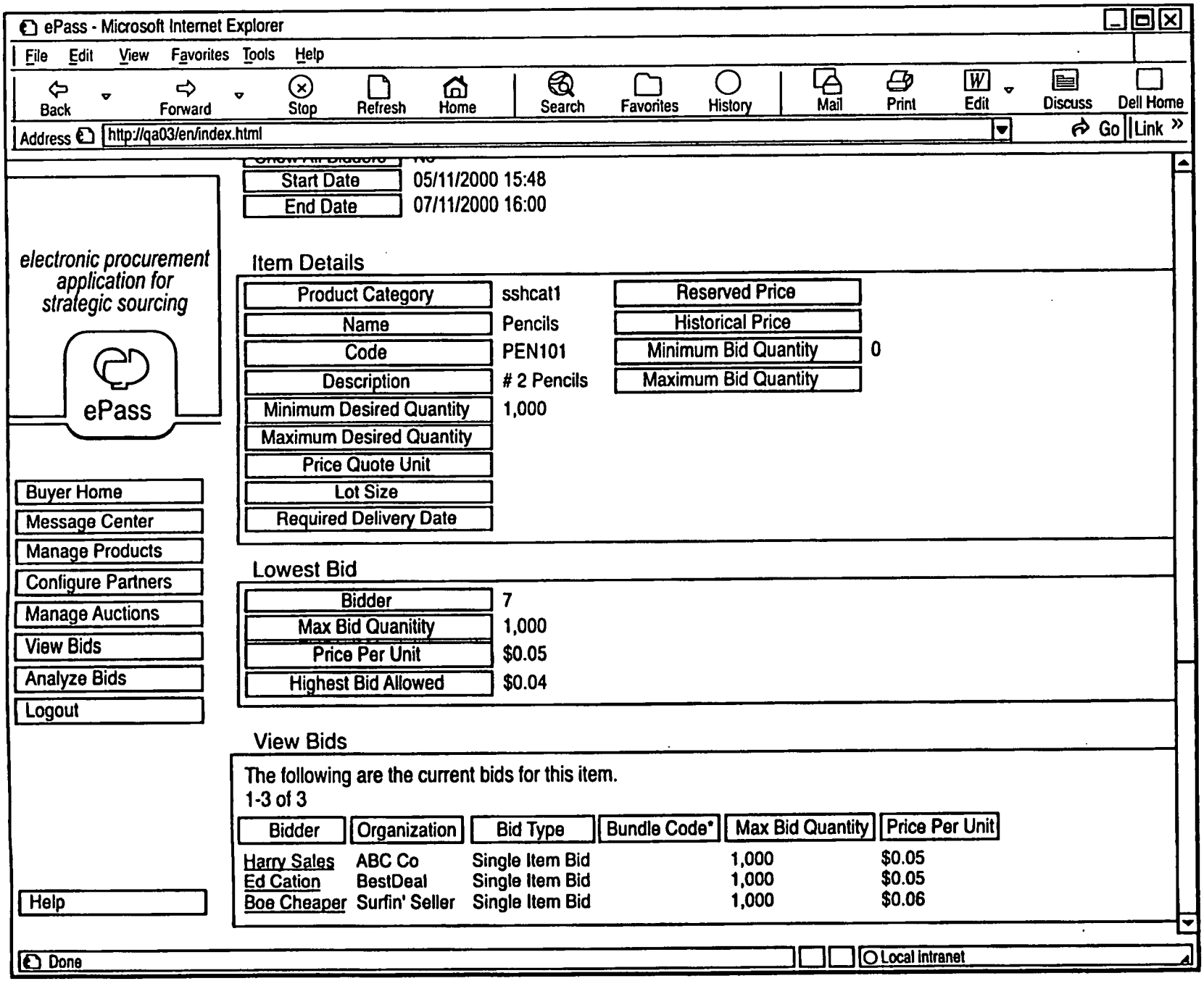

FIG. 15B

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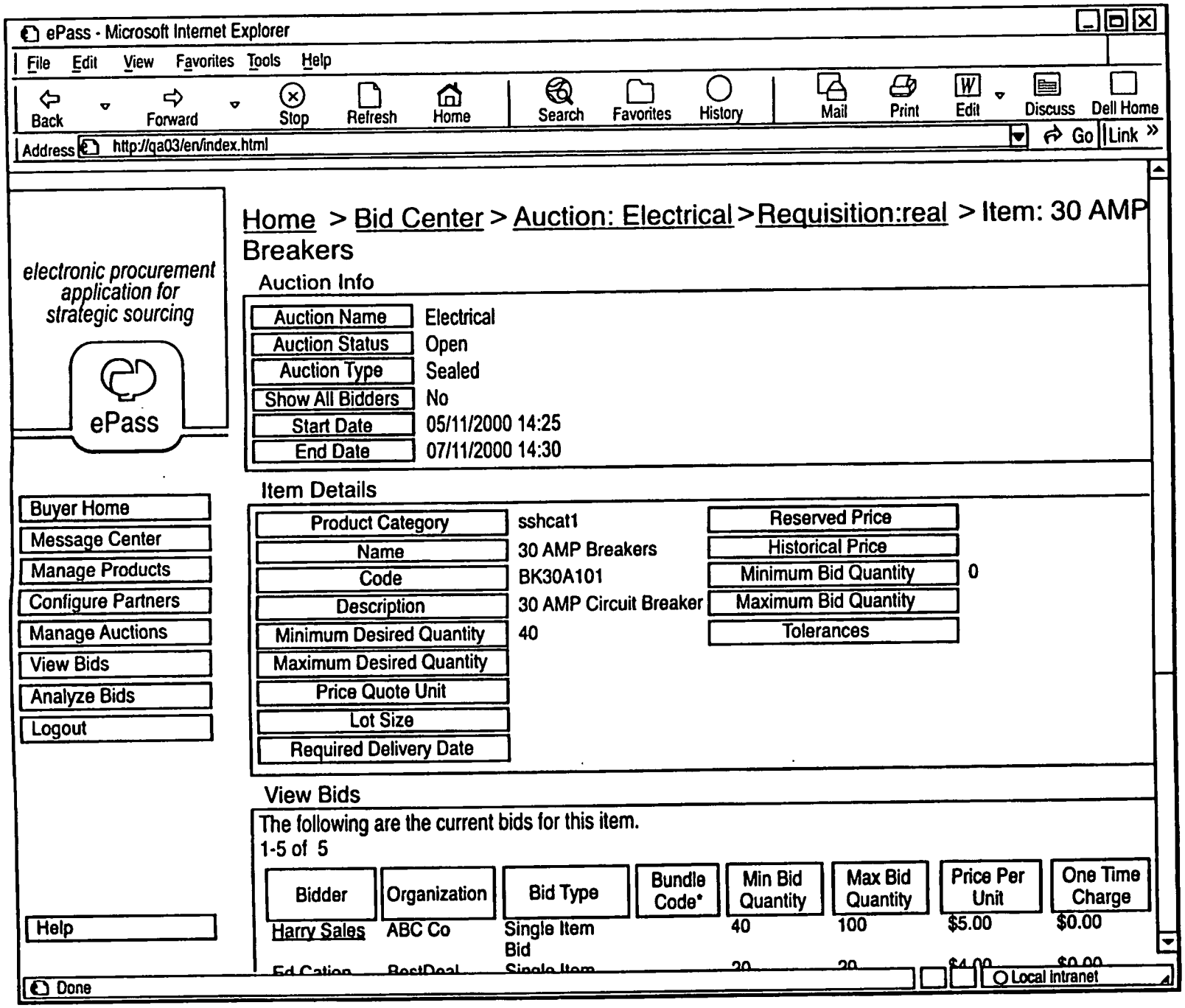

FIG. 16A

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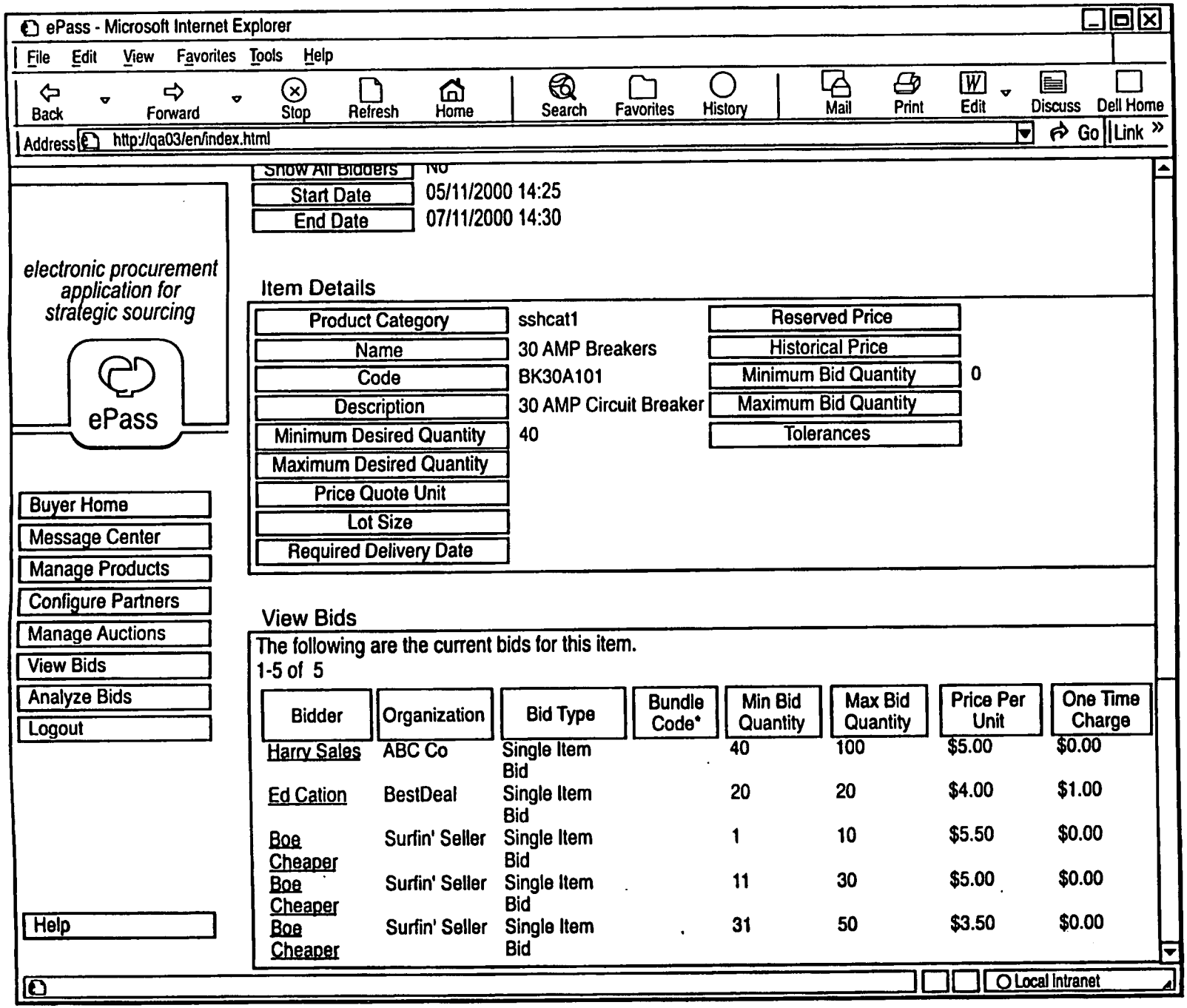

FIG. 16B

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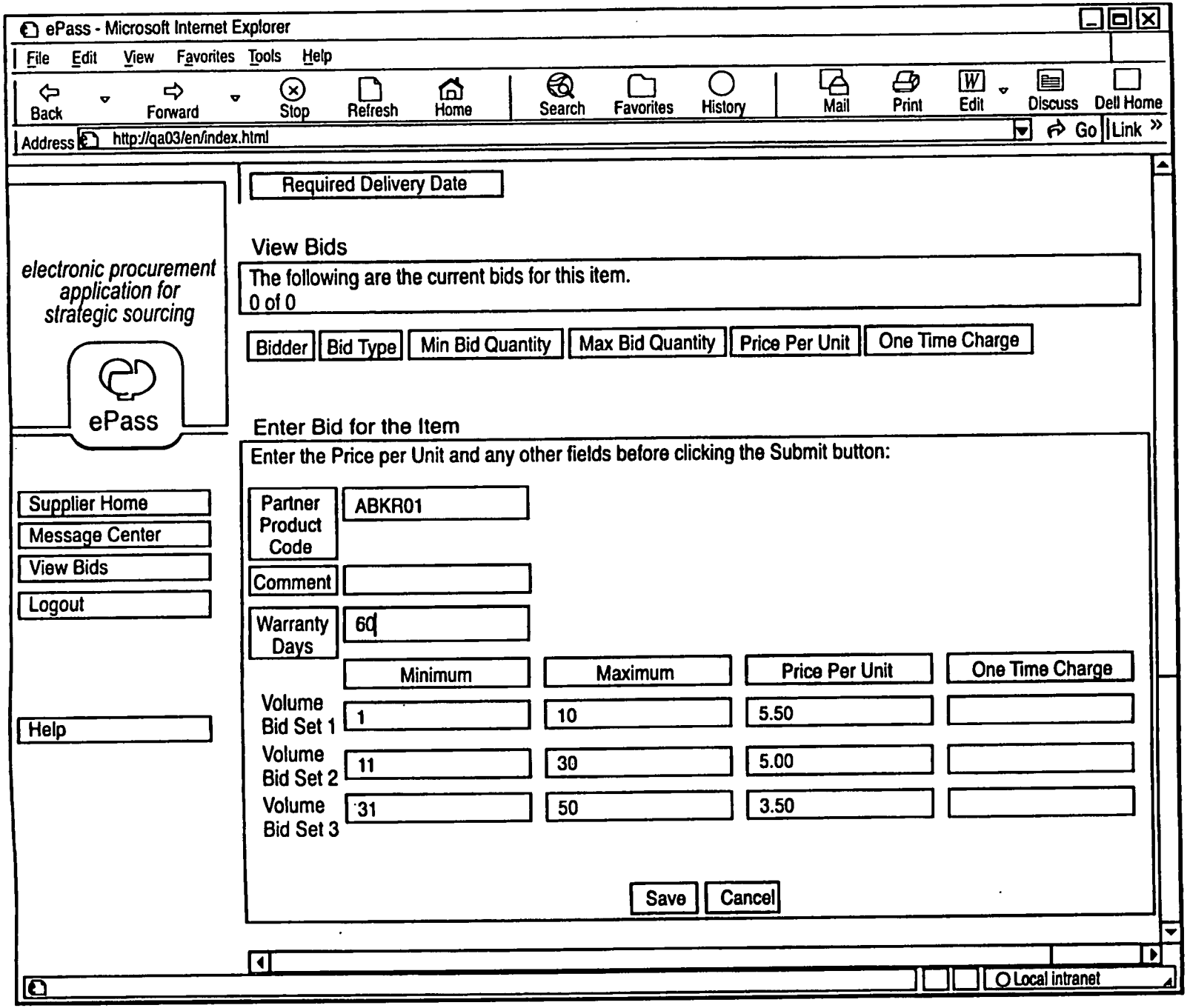

FIG. 17

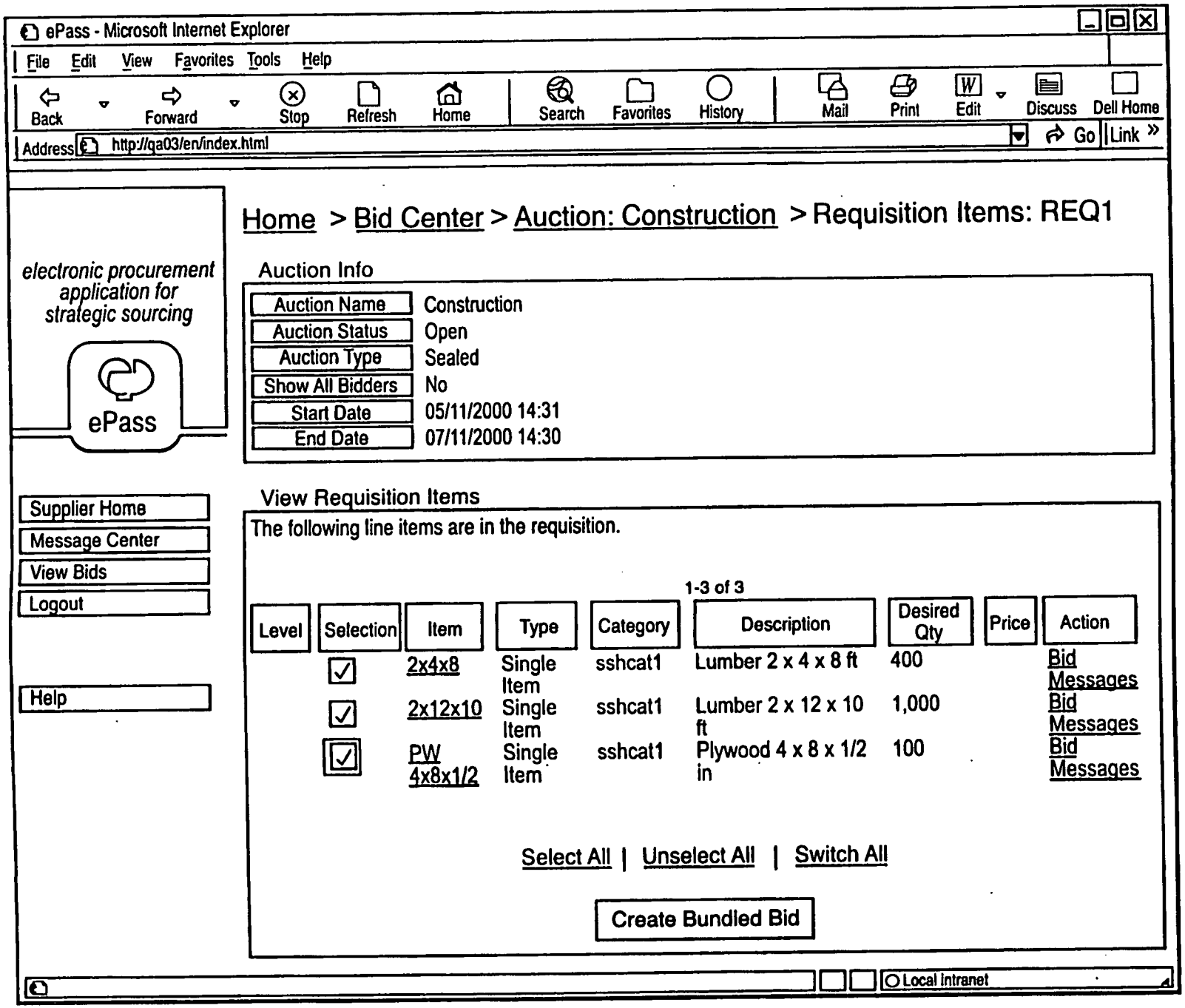

FIG. 19

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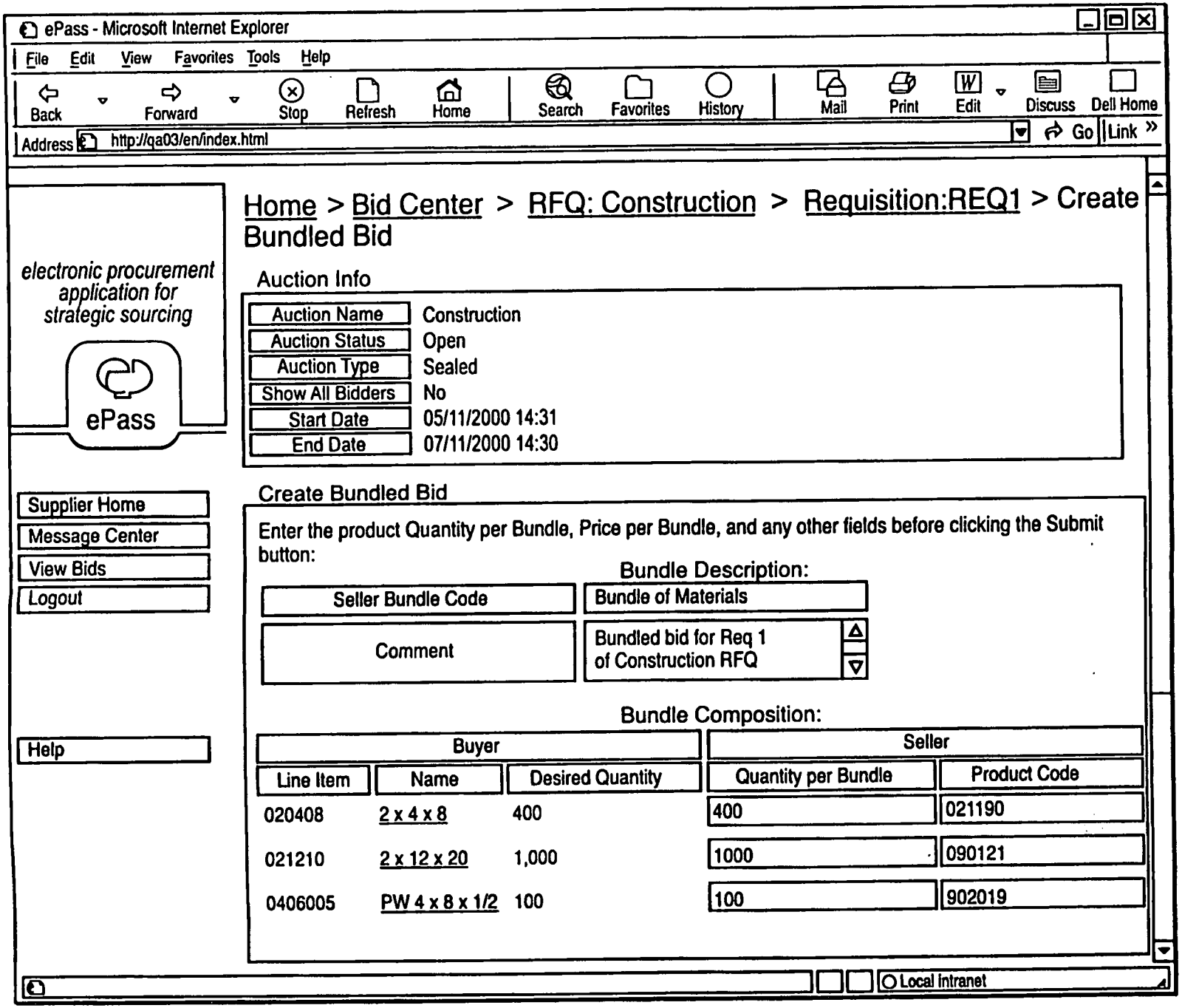

FIG. 20A

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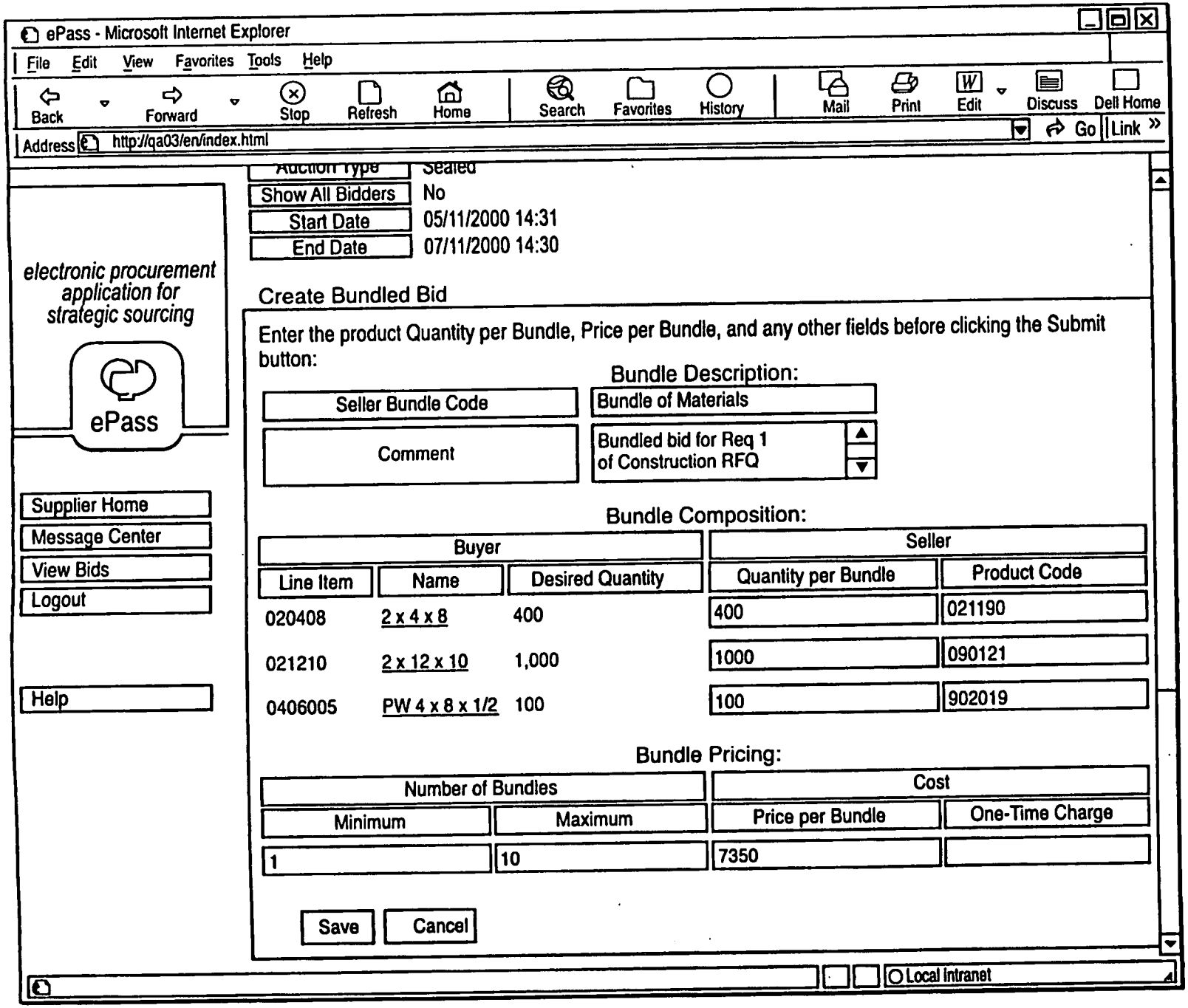

FIG. 20B

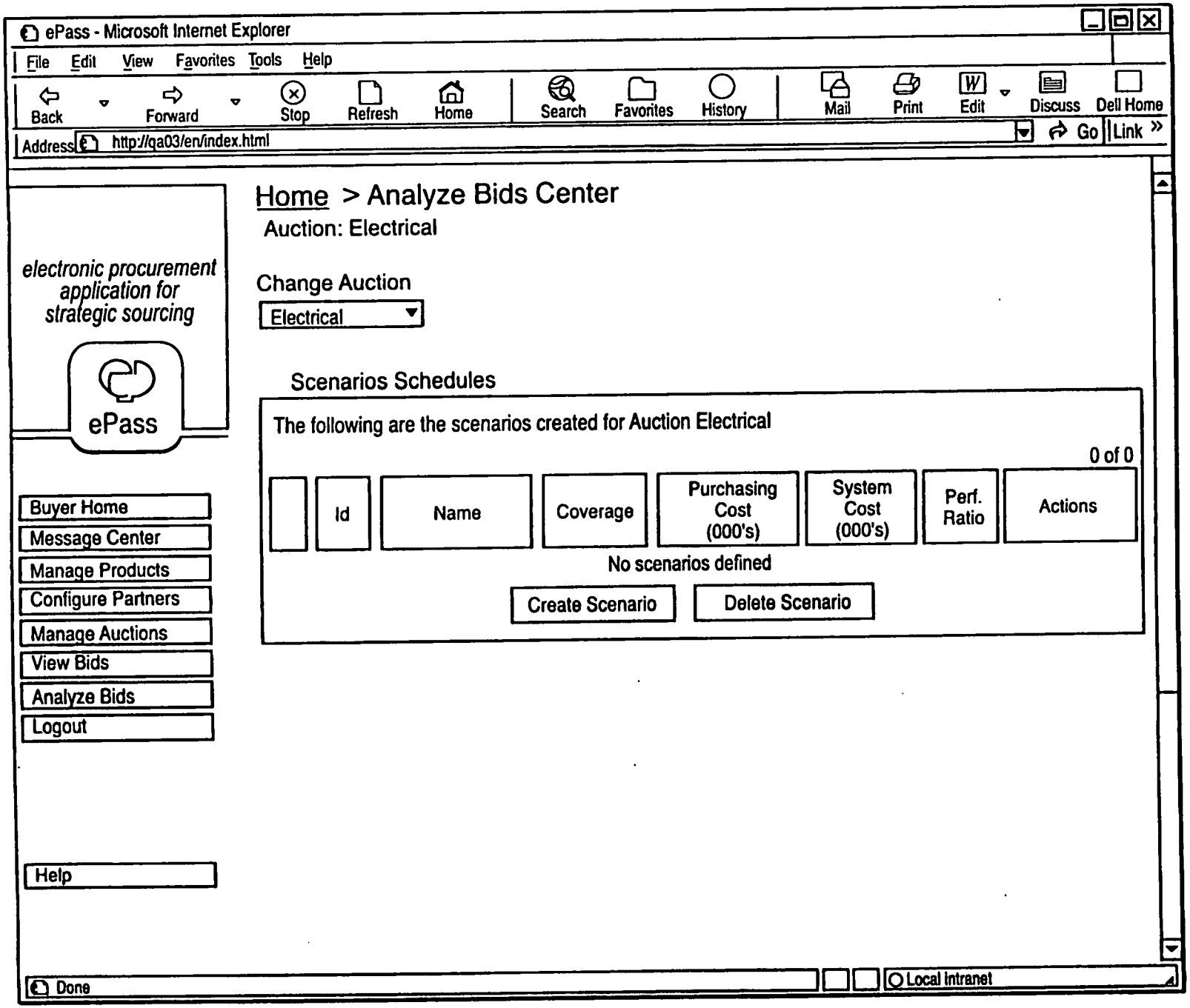

FIG. 21

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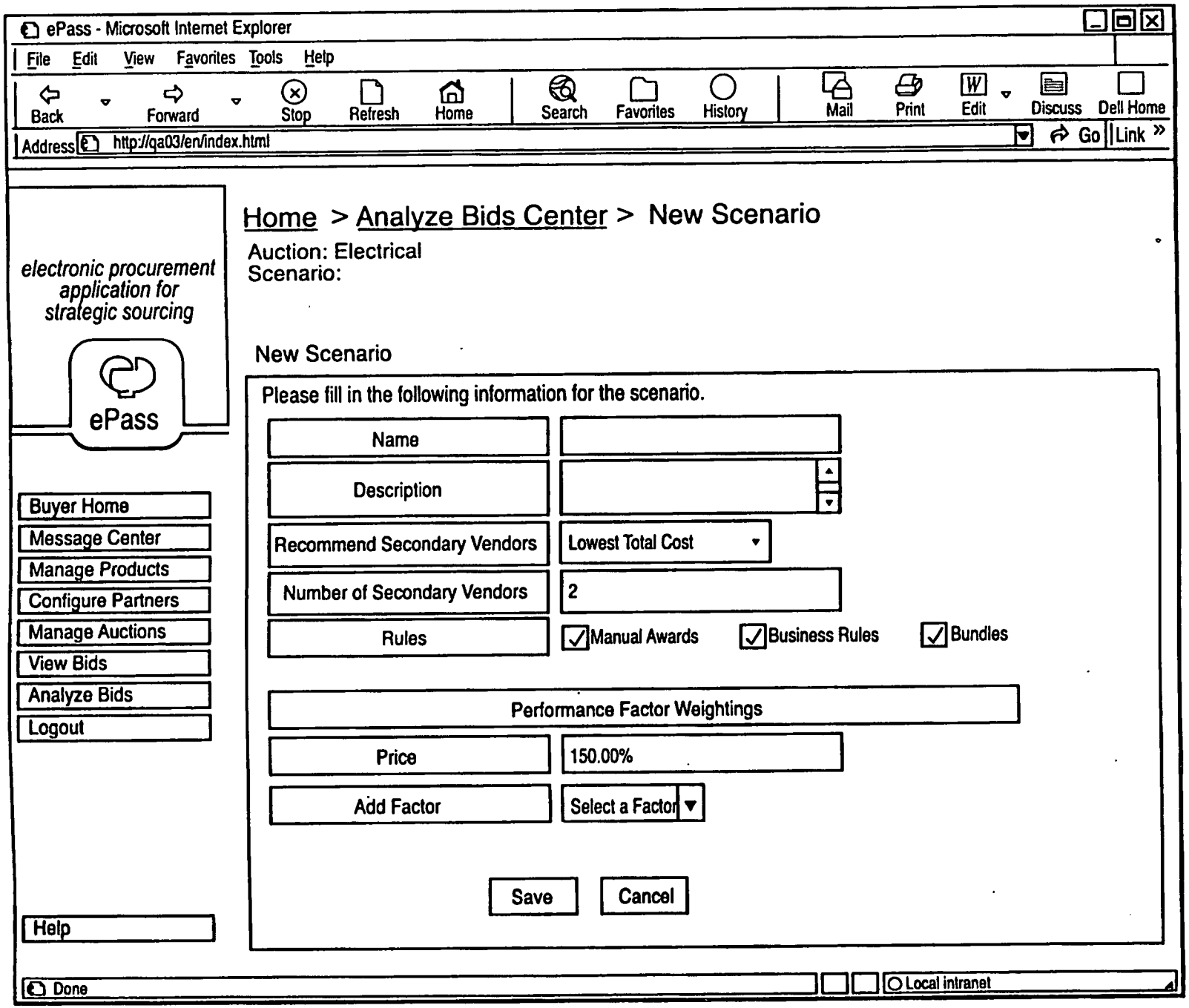

FIG. 22

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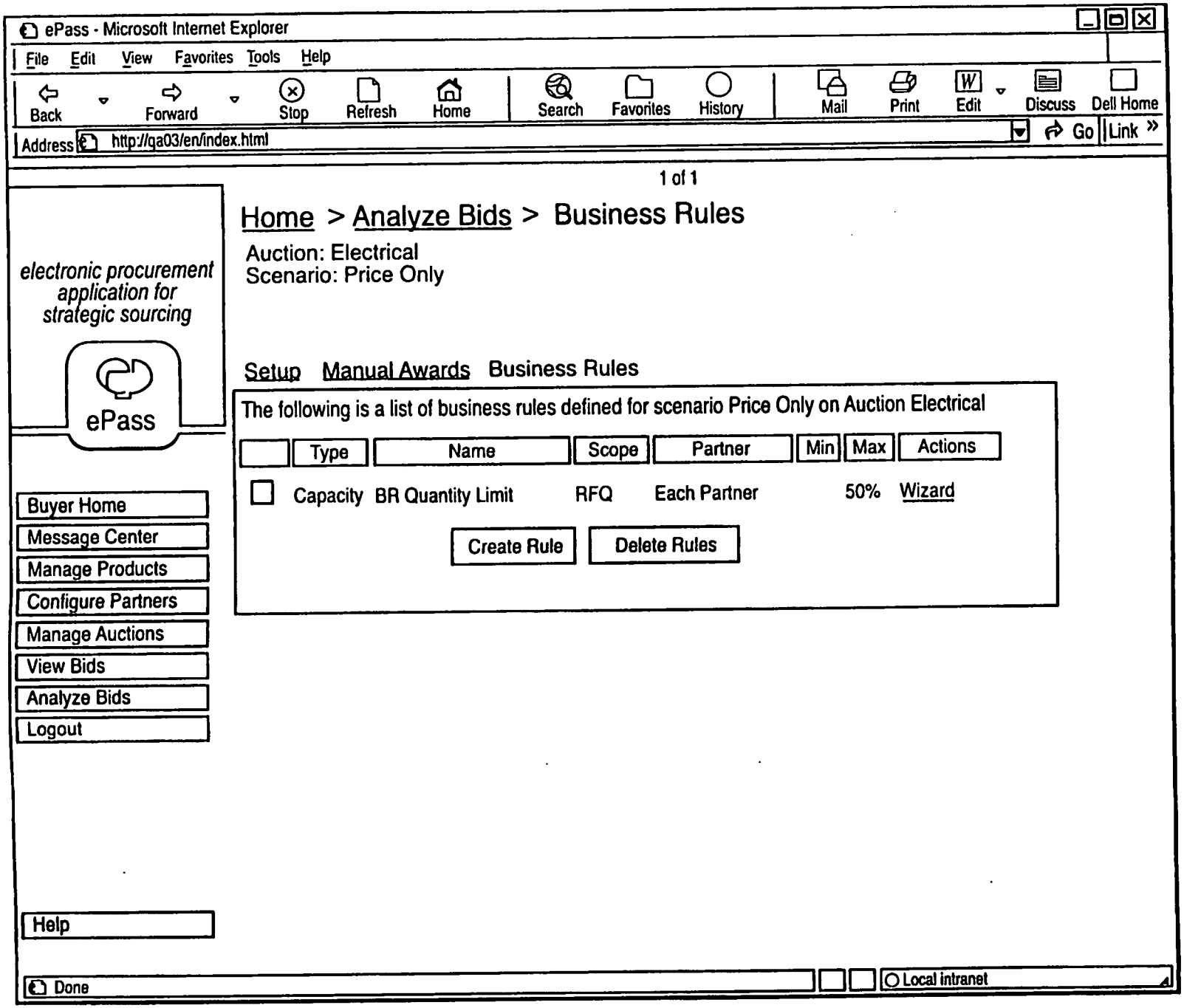

FIG. 23

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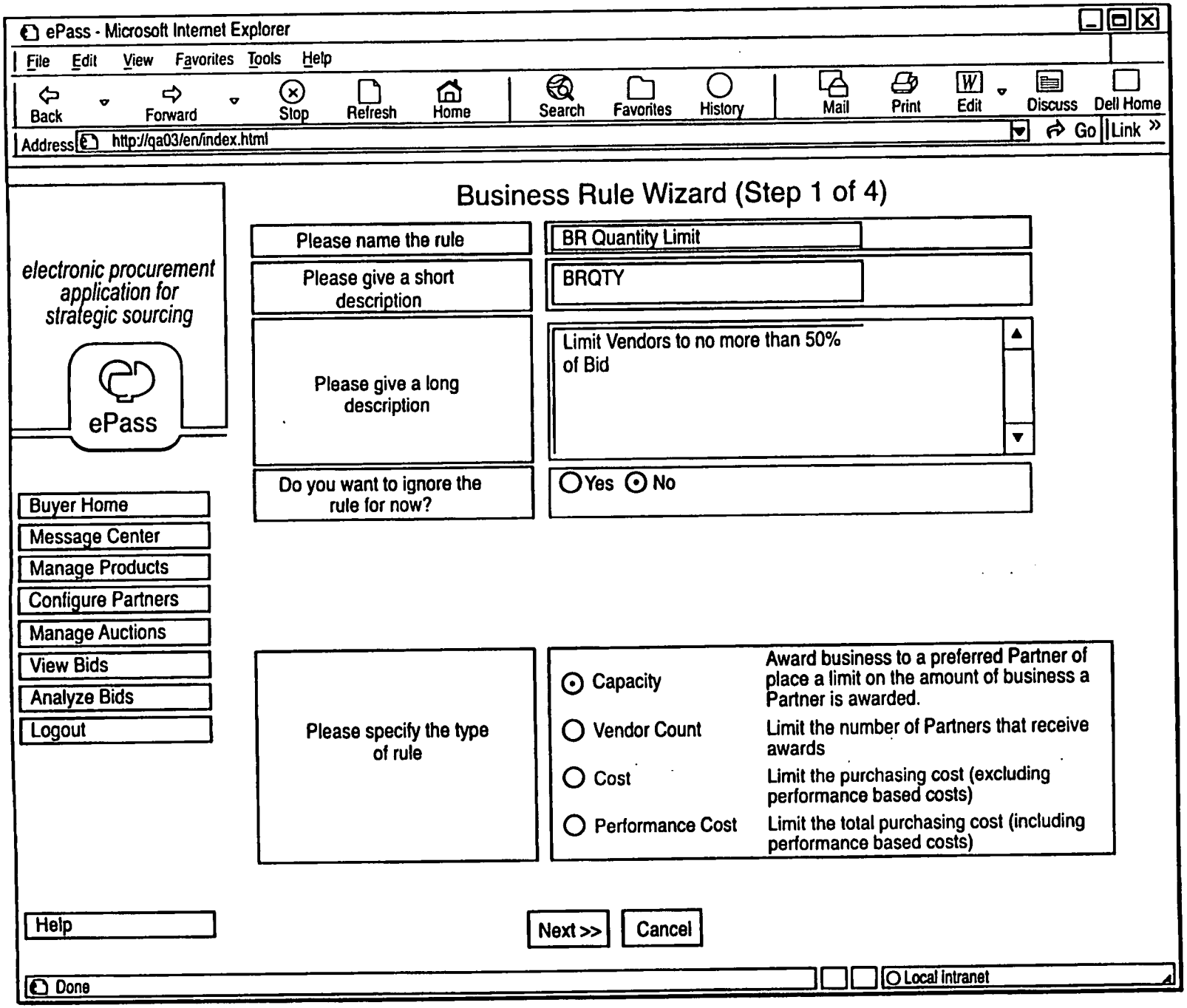

FIG. 24

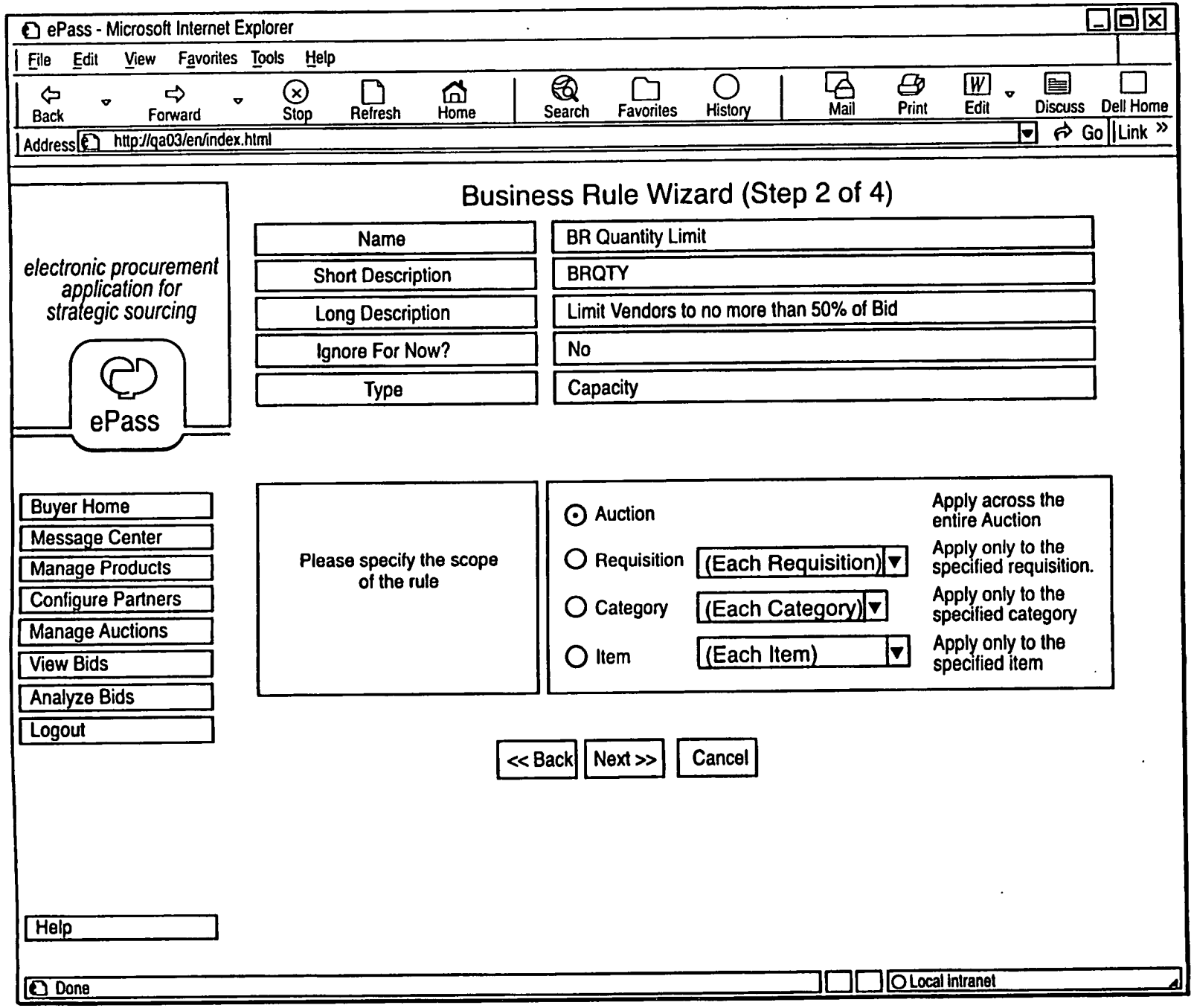

FIG. 25

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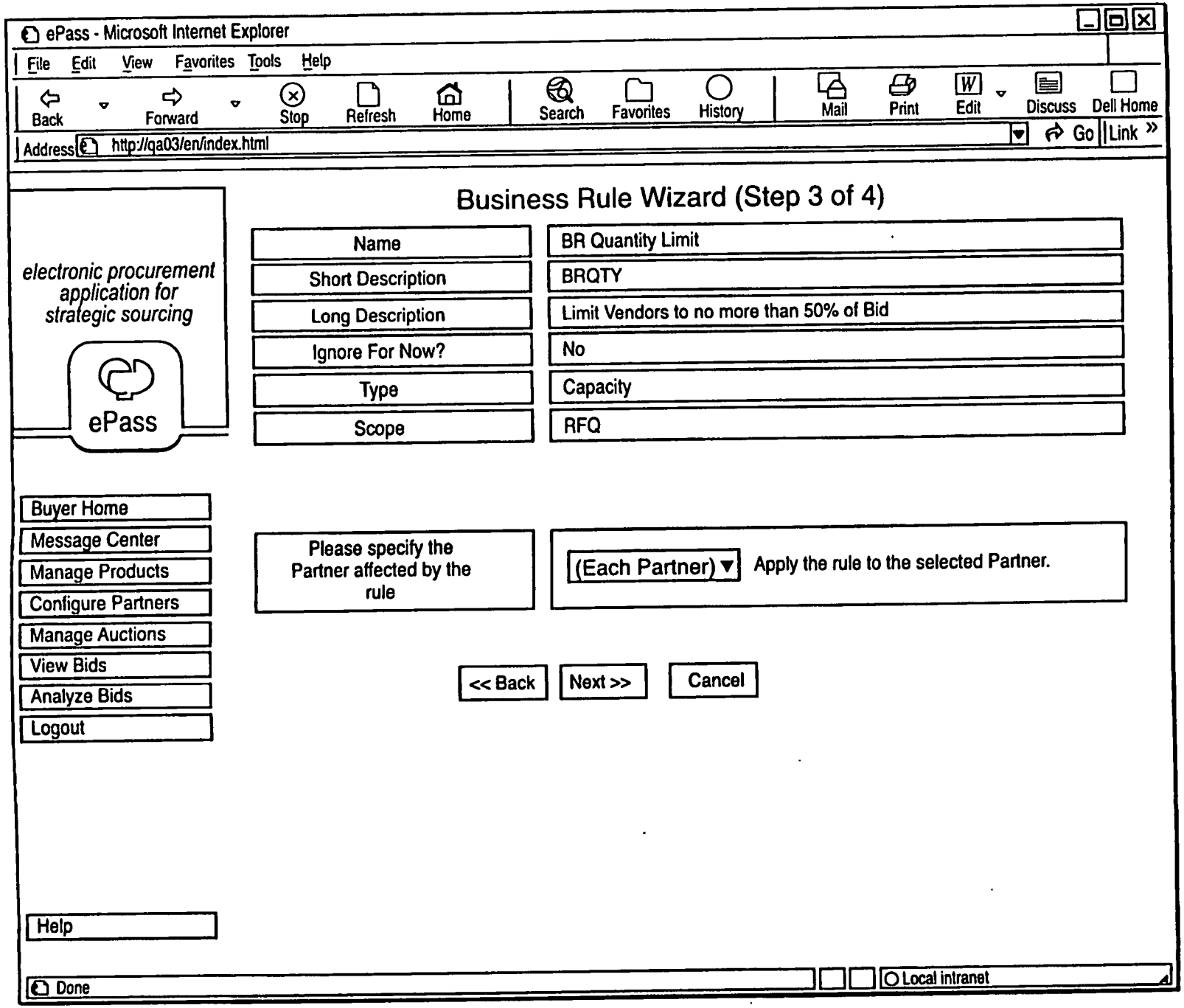

FIG. 26

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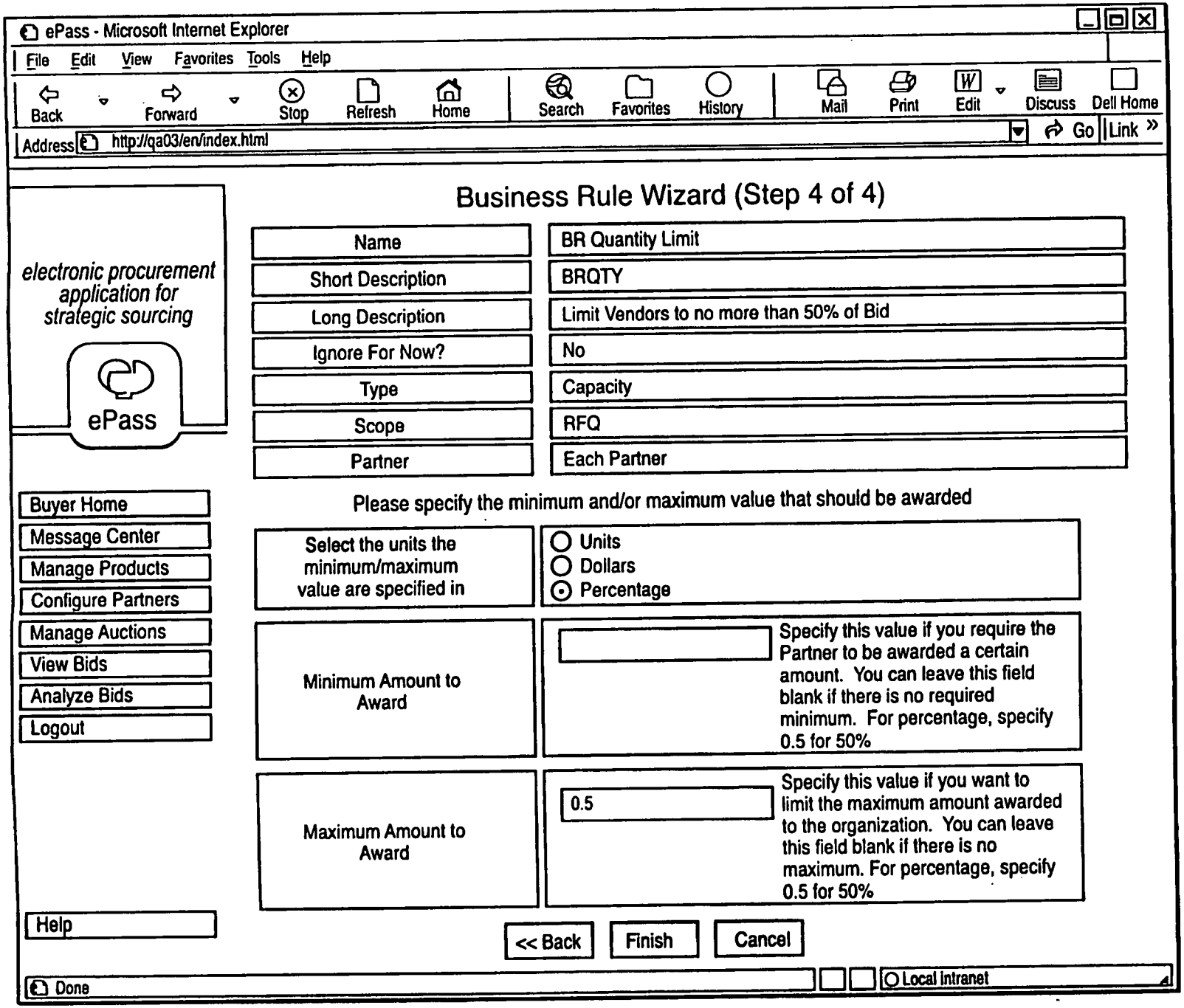

FIG. 27

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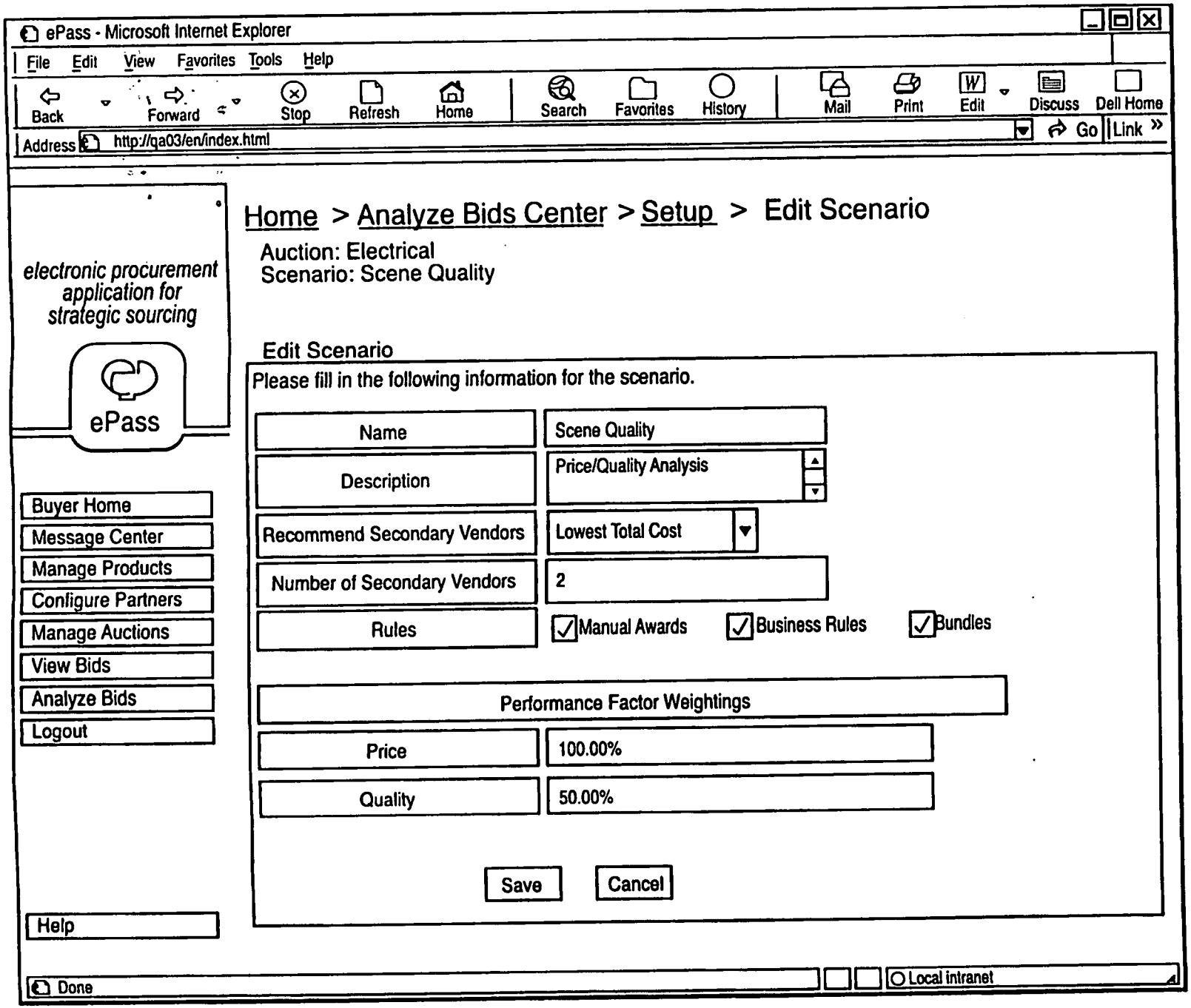

FIG. 28

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